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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/446,641	12/22/1999	TSUYONOBU HATAZAWA	P99.2641	2680

26263 7590 07/28/2004

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EXAMINER

DOVE, TRACY MAE

ART UNIT	PAPER NUMBER
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1745

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b>	Application No. 09/446,641	Applicant(s) HATAZAWA ET AL.	
	Examiner Tracy Dove	Art Unit 1745	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 12 July 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_.

3. ☒ Applicant's reply has overcome the following rejection(s): see attached sheet.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 10,13-17 and 20-28.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☒ Other: see attached sheet

**Attachment to Advisory Action of 7/22/04:**

The objection to claim 13 is withdrawn.

The 35 U.S.C. 112, 1<sup>st</sup>, rejection of claims 20, 21, 27 and 28 is withdrawn.

The 35 U.S.C. 112, 2<sup>nd</sup>, rejection of claims 13, 20, 21, 27 and 28 is withdrawn.

**Yasugata**

Applicant does not specifically argue the anticipation rejection of claims 22 and 25-28 in view of Yasugata. Claim 22 does not recite “two ranges” as argued by Applicant in the after final response of 7/12/04. Both the claimed invention and Yasugata disclose a fluorocarbon polymer having a weight average molecular weight of 1,000,000. Thus, Yasugata teaches the claimed invention with “sufficient specificity”.

**Gao**

Applicant does not specifically argue the anticipation rejection of claims 10, 13-17 and 20-28 in view of Gao. Applicant argues the MPEP states “if the claims are directed toward a narrow range, the reference teaches a broad range, and there is evidence of unexpected results within the claimed narrow range, depending on the other facts of the case, it may be reasonable to conclude that the narrow range is not disclosed with “sufficient specificity” to constitute an anticipation of the claims”. Applicant then concludes that Gao cites broad ranges which do not disclose subject matter with sufficient specificity to constitute an anticipation under the statute.

However, Applicant’s application of the statute to the facts of the case is flawed. First, a polymer weight average molecular weight of greater than 550,000 is not a narrow range. Furthermore, a polymer weight average molecular weight of greater than 300,000 and less than 550,000 is not a narrow range. Second, evidence of unexpected results must distinguish the

Art Unit: 1745

claimed invention over the prior art of record. No such evidence of unexpected results has been provided.

Humphrey

Applicant does not specifically argue the anticipation rejection of claims 10, 13-17 and 22-26 in view of Humphrey. Applicant argues the MPEP states “if the claims are directed toward a narrow range, the reference teaches a broad range, and there is evidence of unexpected results within the claimed narrow range, depending on the other facts of the case, it may be reasonable to conclude that the narrow range is not disclosed with “sufficient specificity” to constitute an anticipation of the claims”. Applicant then concludes that Humphrey cites broad ranges which do not disclose subject matter with sufficient specificity to constitute an anticipation under the statute.

However, Applicant’s assertions regarding the Humphrey reference are incorrect. Examiner points out Table III that teaches at least two polymers (first two listed) having molecular weights that fall within the claimed ranges for producing the copolymer of Humphrey. Table IV also describes the combination of medium and high molecular weight grade polymers to provide a PVDF homopolymer.

Furthermore, Applicant’s application of the statute to the facts of the case is flawed. First, a polymer weight average molecular weight of greater than 550,000 is not a narrow range. Furthermore, a polymer weight average molecular weight of greater than 300,000 and less than 550,000 is not a narrow range. Second, evidence of unexpected results must distinguish the claimed invention over the prior art of record. No such evidence of unexpected results has been provided.

Art Unit: 1745

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tracy Dove whose telephone number is 571-272-1285. The examiner can normally be reached on Monday-Thursday (9:00-7:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pat Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

July 23, 2004

  
Patrick Ryan  
Supervisory Patent Examiner  
Technology Center 1700